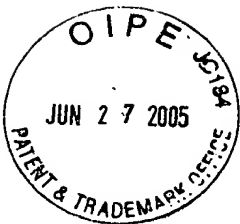


AF
JW



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Appeal No. (not yet assigned) :
In re Application of :
NEREIDA MARIA MENENDEZ et al. : Group Art Unit: 3629
Serial No. 09/698,502 : Examiner: Naresh Vig
Filed: October 27, 2000 : Attorney Docket No. 285277-00018
METHOD FOR COMPLETING : Confirmation No. 6442
AND STORING AN ELECTRONIC :
RENTAL AGREEMENT :

APPELLANT'S REPLY BRIEF

June 24, 2005

Mail Stop Appeal Brief-Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Sir:

Appellant's Reply Brief under 37 CFR § 41.41 is in reply to the Examiner's Answer, mailed on April 25, 2005, for the above-captioned application.

In the Examiner's Answer (p. 3, Grouping of Claims), the Examiner cites 37 CFR § 1.192(c)(7) for the proposition that Claims 1-18 stand or fall together. This position is not well taken since 37 CFR § 1.191 provides that appeals to the Board are conducted according to part 41 of the same title. Hence, 37 CFR § 41.37(c)(vii) controls. Appellant has, under the Argument section of Appellant's Appeal Brief, separately argued Claims 1, 4, 12, 18, 6 and 13, in that order. Those claims are clearly placed under a subheading identifying the claim by number. Furthermore, 37 CFR § 1.192 was removed and reserved effective September 13, 2004, and does not apply to the present Appeal.

Under the Grounds for Rejection section of the Examiner's Answer (pp. 3-12), the Examiner's remarks appear to be a substantial copy of the Claim Rejections section from the Final Office Action, mailed on May 11, 2004. Hence, the following remarks are substantially directed to the Response to Argument section of the Examiner's Answer (pp. 13-16).

Claim terms are presumed to have the ordinary and customary meanings attributed to them by those of ordinary skill in the art. *Sunrace Roots Enter. Co. v. SRAM Corp.*, 336 F.3d 1298, 1302, 67 U.S.P.Q.2d 1438, 1441 (Fed. Cir. 2003).

The proper focus for the meaning of a claim term is the ordinary and customary meaning attributed to it by those of ordinary skill in the relevant art. It is respectfully submitted that a claim term is not presumed to have all possible meanings attributed to them by an Examiner. During patent examination, the pending claims must be given their broadest “reasonable” interpretation consistent with the specification. *In re Hyatt*, 211 F.3d 1367, 1372, 54 U.S.P.Q.2d 1664, 1667 (Fed. Cir. 2000).

The broadest reasonable interpretation of the claims must also be consistent with the interpretation that those of ordinary skill in the art would reach. *In re Cortright*, 165 F.3d 1353, 1359, 49 U.S.P.Q.2d 1464, 1468 (Fed. Cir. 1999). In *Cortright*, the Board’s construction of the claim limitation “restore hair growth” as requiring the hair to be returned to its original state was held to be an incorrect interpretation of the limitation. The court held that, consistent with applicant’s disclosure and the disclosure of three patents from analogous arts using the same phrase to require only some increase in hair growth, one of ordinary skill would construe “restore hair growth” to mean that the claimed method increases the amount of hair grown on the scalp, but does not necessarily produce a full head of hair. *Cortright*, 165 F.3d at 1359, 49 U.S.P.Q.2d at 1468.

The use of “electronic rental agreement” in the claims and Appellant’s definition thereof (*i.e.*, electronic rental contract which is legally binding on the parties entering into it) is entirely consistent with the interpretation that those of ordinary skill in the art would reach. See, for example, “Information on Hertz Corporation, 1997 - 2000” (Hertz) (p. 34) (“... when the car is used in accordance with all terms and conditions of the rental agreement.”). A true and correct copy of this page of Hertz, of record, is attached hereto as Appendix 4 for the convenience of reference by the Board. This reference, which was cited by the Examiner and which does not teach or suggest an **electronic** rental agreement, favors the use of the term “rental agreement” over the term “rental contact”.

In the Examiner’s Answer (Response to Argument) (p. 13, ¶1), the Examiner provides four different definitions for a “rental agreement”. Also, in the Examiner’s Answer (p. 4, ¶3; p. 8, ¶1), the Examiner states that he “reads rental agreement as an arrangement between parties regarding a course of action; a covenant”). It is submitted that the Board may take judicial notice from the renting of a vehicle from a company, such as Hertz or the like, that such a company would not permit a vehicle to be taken and used by a renter in the

absence of a rental agreement (*i.e.*, a rental contract which is legally binding on the parties entering into it).¹ As was shown above, in connection with Hertz, this is also the broadest reasonable interpretation that those of ordinary skill in the art would reach. In other words, such a company would not permit a vehicle to be taken and used by a renter when there was a mere “arrangement between parties regarding a course of action” as was asserted by the Examiner. Hence, the Examiner’s position is not reasonable and is not what those of ordinary skill in the art would reach.

Such a position, as taken by the Examiner, is also inconsistent with Appellant’s specification at page 12, line 6 (“accepted rental contract”). Furthermore, Figure 6K of Appellant’s application (*emphasis added*) provides:

I rent from you the car described on the receipt I receive at the renting location. I agree to the terms set forth below and any added pages, including the **rental agreement** jacket I will receive at the renting location. All changes must be made via XYZ.com prior to picking up the car, or at the rental counter. The name and address I have provided on this **rental agreement** ...

Furthermore, Figure 6K provides that “If you do not want to accept the Terms and Conditions of this contract we will still hold your car and you can pick it up at the rental counter”. Hence, Appellant’s specification and drawings make clear that “rental agreement” means the same as a rental contract and that the accepted rental proposal forms a rental agreement having legally binding terms and conditions on the parties.

In the Examiner’s Answer (Response to Argument) (for example, without limitation, p. 13, ¶2; p. 13, ¶3; p. 14, ¶1; p. 14, ¶3; p. 15, ¶1, among others), the Examiner states that Appellant “is arguing a contract, but, the appellant is not claiming a contract”. Actually, what has been very consistently presented by Appellant is an “electronic rental agreement (*i.e.*, electronic rental contract which is legally binding on the parties entering into it),” which is the broadest reasonable interpretation consistent with both the Appellant’s specification and with the interpretation that those of ordinary skill in the art would reach.

As to the Examiner’s statement (Examiner’s Answer (Response to Argument) p. 13, ¶2; p. 14, ¶4; p. 15, ¶3) about “reservation agreements,” Appellant has not focused on the meaning of the single word “agreement”. The claim term is, instead, “rental agreement” or “electronic rental agreement”. Appellant does not claim any “reservation agreement”.

¹ It is submitted that this fact is well known and capable of instant and unquestionable demonstration as being well-known by anyone who has rented a vehicle from a company, such as Hertz or the like.

A reasonable interpretation of “reservation agreement” from the cited references, in most² instances, is that a reservation is not binding on the parties. See, for example, Appellant’s Figure 6K which provides that “If you do not want to accept the Terms and Conditions of this contract we will still hold your car and you can pick it up at the rental counter”. Hence, Appellant has expressly disclosed that a reservation is not binding on the parties.

In the Examiner’s Answer (Response to Argument) (p. 14, ¶2), the Examiner states that “Appellant is arguing a limitation which is not claimed by the appellant”. Actually, page 5, paragraph 4 through page 6, paragraph 2 and note 2 of Appellant’s Appeal Brief make clear that, at best, Hertz and Avis teach or suggest an electronic reservation, which subsequently requires a future printed and hand-signed physical rental agreement, since there is no meeting of the minds between Hertz and the user as to exact price and to exact optional items associated with the reservation. Appellant is clearly arguing why the cited references do not teach or suggest electronically accepting a **rental** proposal; and **storing** an **electronic rental** agreement (*i.e.*, electronic rental contract, which is legally binding on the parties entering into it) based upon an accepted **rental** proposal.

In the Examiner’s Answer (Response to Argument) (p. 15, ¶2), the Examiner refers to the language of independent Claim 1 and dependent Claim 4, which deal with what the Examiner refers to as “limitation (b),” namely, entering at least some of the rental-related information from a master rental agreement; and allowing modification of the information from the master rental agreement for rental of the item or service without modifying the master rental agreement. Appellant has clearly separately argued that limitation as applied to dependent Claim 4 on pages 10 and 11 of the Appeal Brief. In the Examiner’s Answer (Response to Argument) (p. 16, ¶1), the Examiner does not address the point that the cited references do not teach or suggest that a customer can modify information from a master rental agreement **without modifying** the master rental agreement.

In the Examiner’s Answer (Response to Argument) (p. 16, ¶2), the Examiner refers to using a flag to store information as being an old and known design choice used in programming, and to it being a design choice to decide what data fields to use flags for storing information. It is submitted that it is improper to fail to consider Appellant’s Claims 1, 10, 11 and 12, taken as a whole.

² See, however, a discussion of a reservation from Hertz having a penalty clause at page 14, paragraph 3 of Appellant’s Appeal Brief. That, however, has nothing to do with the broadest reasonable interpretation of “electronic rental agreement” consistent with both the Appellant’s specification and with the interpretation that those of ordinary skill in the art would reach. Again, Appellant does not claim a “reservation agreement”.

[W]hen evaluating the scope of a claim, **every** limitation in the claim must be considered. Office personnel may **not** dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, **the claim as a whole must be considered**. See, e.g., *Diamond v. Diehr*, 450 U.S. at 188-89, 209 U.S.P.Q. at 9.

MPEP § 2106 (**emphasis added**).

Also, the Examiner errs by not considering the refined recital of Claim 12 of storing a flag along with a unique transaction in a database system to indicate that an accepted **rental** proposal is **electronically signed**. Furthermore, it is not appropriate for the Examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known within the context of the claims at issue.

It would not be appropriate for the examiner to take official notice of facts without citing a prior art reference where the facts asserted to be well known are not capable of instant and unquestionable demonstration as being well-known. For example, assertions of technical facts in the areas of esoteric technology or specific knowledge of the prior art must always be supported by citation to some reference work recognized as standard in the pertinent art.

In re Ahlert, 424 F.2d 1088, 1091, 165 U.S.P.Q. 418, 420-21 (CCPA 1970).

Hence, it is submitted that the Examiner has failed to cite a pertinent reference within the context of Appellant's Claims 1, 10, 11 and 12, taken as a whole.

Conclusion

Claims 1-18 are patentable over the prior art of record. Therefore, it is requested that the Board reverse the Examiner's rejections of Claims 1-18 and remand the application to the Examiner for the issuance of a Notice of Allowance.

Respectfully submitted,



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APPENDIX 4 (“Information on Hertz Corporation, 1997 - 2000” (Hertz) (p. 34))



BEST AVAILABLE COPY

Hertz Customer Service: Frequently Asked Questions - Microsoft Internet Explorer provided by USPTO

Address <http://web.archive.org/web/20000604174204/hertz.com/company/faq/faq.cfm?category=IRES>

fees) are included in your rate quote.

19 Is LDW Included in the rate quoted?

This depends on the location and rate plan that you have selected. If it is included, you will see it listed in the "Mandatory Items" or "Inclusive Items" section. If it is not included, it will be listed within the "Optional Items" section.

20 Is Insurance Included in the rate quoted?

The provisions of liability protection vary from state to state and country to country. In the U.S., Hertz provides at no extra charge, on either primary or secondary basis depending on the state (except for California), basic liability protection for bodily injury and property damage to third parties within limits when the car is used in accordance with all terms and conditions of the rental agreement.

21 With my personal car Insurance or charge card LDW coverage, do I need to purchase LDW from Hertz?

Only you can make that decision. For information on what your personal insurance covers, you should check with your insurance agent. To check on the benefits from your charge card, you should check with the charge card's customer service department. Then you can decide if you wish to accept LDW.

22 The box to enter my airline flight number is not long enough.

If your flight number contains letters and numbers, please enter only the numeric information.

23 What qualifies as a "weekend" rental?

Generally, rentals picked up beginning Noon on Thursday through Noon Sunday qualify for the weekend rate, provided the rental is kept over a Saturday night. There are, however, some exceptions to the Saturday night keep rule and extra day charges do apply for any rental not returned by end of day Monday.

If you have any further questions, you can [contact us](#) by e-mail.

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Start | Hertz Customer S... | HertzCom... Microsoft | Tuesday, September 24, 2002 12:30 PM



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TRANSMITTAL FORM

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Total Number of Pages in This Submission

11

Application Number 09/698,502

Filing Date October 27, 2000

First Named Inventor NEREIDA MARIA MENENDEZ

Art Unit 3629

Examiner Name Naresh Vig

Attorney Docket Number 285277-00018

ENCLOSURES (Check all that apply)

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Date	June 24, 2005	Reg. No.	37,357

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<input type="checkbox"/> Applicant claims small entity status. See 37 CFR 1.27		Application Number	09/698,502
TOTAL AMOUNT OF PAYMENT (\$ 500.00)		Filing Date	October 27, 2000
		First Named Inventor	NEREIDA MARIA MENENDEZ
		Examiner Name	Naresh Vig
		Art Unit	3629
		Attorney Docket No.	285277-00018

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1. BASIC FILING, SEARCH, AND EXAMINATION FEES

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	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	Fee (\$)	Small Entity Fee (\$)	
Utility	300	150	500	250	200	100	
Design	200	100	100	50	130	65	
Plant	200	100	300	150	160	80	
Reissue	300	150	500	250	600	300	
Provisional	200	100	0	0	0	0	

2. EXCESS CLAIM FEES

Fee Description	Fee (\$)	Small Entity Fee (\$)
Each claim over 20 or, for Reissues, each claim over 20 and more than in the original patent	50	25
Each independent claim over 3 or, for Reissues, each independent claim more than in the original patent	200	100
Multiple dependent claims	360	180

Total Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

HP = highest number of total claims paid for, if greater than 20

Indep. Claims **Extra Claims** **Fee (\$)** **Fee Paid (\$)**

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If the specification and drawings exceed 100 sheets of paper, the application size fee due is \$250 (\$125 for small entity) for each additional 50 sheets or fraction thereof. See 35 U.S.C. 41(a)(1)(G) and 37 CFR 1.16(s).

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4. OTHER FEE(S)

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Signature <u>Kirk D. Houser</u>	Registration No. (Attorney/Agent) <u>37,357</u>	Telephone <u>412.566.6083</u>
Name (Print/Type) <u>Kirk D. Houser</u>	Date <u>June 24, 2005</u>	

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